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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/792,297

03/04/2004

Fumiko Shiraishi

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EXAMINER

SHEEHAN, JOHN P

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

08/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/792,297	Applicant(s) SHIRAISHI ET AL.	
	Examiner John P. Sheehan	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. The rejection of claims 1 to 14 under 35 U.S.C. 103(a) as being unpatentable over Murray '119 (US Patent Application Publication No. US 2001/0009119) in view of Thumm '332, (US Patent No. 6,221,332) has been overcome by applicants' amendments to the claims and applicants' arguments.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 to 14 are rejected under 35 U.S.C. 103(a) as being obvious over each of Hattori et al. (Hattori '458, US 2004/0005458); Hattori et al. (Hattori '357, US 2004/0033357); Hattori et al. (Hattori '868, US 2004/0170868); Hattori et al. (Hattori '276, US 2004/0137276); Hattori et al. (Hattori '747, US 2004/0091747); Waki et al. (Waki '242, US 2003/0203242) or Waki et al. (Waki '978, US 7,066,978) each taken in view of Thumm et al. (Thumm '332, US 6,221,332).

The applied references have a common assignee and inventors with the instant application. Based upon the earlier effective U.S. filing date of the references, the

references constitute prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Each of Hattori '458, Hattori '357, Hattori '868, Hattori '276, Hattori '747, Waki '242, Waki '978 teach making magnetic particles capable of forming a CuAu or Cu₃Au hard magnetic ordered alloy phase by the reverse micelle process comprising combining reactant streams in a reactor (Hattori '458, paragraphs [0021], [0022] and [0045]; Hattori '357, paragraphs [0037], [0038] and [0061]; Hattori '868, paragraphs [0041] and [0068]; Hattori '276, paragraphs [0029], [0030] and [0053]; Hattori '747, paragraphs [0043] and [0065]; Waki '242, paragraphs [0043] and [0063]; and Waki '978, column 3, lines 47 to 61).

Thumm '332 teaches that pressurized reactant streams having pressures of 8,000 to 50,000 psi (55 to 345 MPa) improves the mixing of the reactants, results in a more efficient reaction (column 1, lines 55 to 68) and provides a more uniform smaller particles size product (column 16, lines 37 to 45). The reactant stream pressure of 8,000 to 50,000 (55 to 345 Mpa) taught by Thumm '332 overlaps the reactant stream pressure of "not less than 1 MPa" recited in the applicants' claims.

The claims and the teachings of the primary references differ in that the primary references do not teach the use of a high pressure reactant stream.

However, one of ordinary skill in the art at the time the invention was made would have been motivated to use high pressure reactant streams in the process taught by each of the primary references so as to improve the mixing of the reactants, the efficiency of the reaction and to provide a more uniform smaller particles size product as taught by Thumm '332.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 to 14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 to 13 of U.S. Patent No. 7,066,978 (Waki '978) in view of Thumm et al. (Thumm '332, US 6,221,332).

Waki '978 claims a method of making magnetic particles capable of forming a CuAu or Cu₃Au hard magnetic ordered alloy phase by the reverse micelle process comprising combining reactant streams in a reactor,

Thumm '332 teaches that pressurized reactant streams having pressures of 8,000 to 50,000 psi (55 to 345 Mpa) improves the mixing of the reactants, results in a more efficient reaction (column 1, lines 55 to 68) and provides a more uniform smaller particles size product (column 16, lines 37 to 45). The reactant stream pressure of 8,000 to 50,000 (55 to 345 Mpa) taught by Thumm '332 overlaps the reactant stream pressure of "not less than 1 MPa" recited in the applicants' claims.

The claims and Waki '978's claims differ in that Waki '978's claims do not recite the use of a high pressure reactant stream.

However, one of ordinary skill in the art at the time the invention was made would have been motivated to use high pressure reactant streams in Waki '978's claims

process so as to improve the mixing of the reactants, the efficiency of the reaction and to provide a more uniform smaller particles size product as taught by Thumm '332.

Response to Arguments

5. Applicant's arguments, see response, filed June 9, 2008, with respect to the Office action mailed November 23, 2007 have been fully considered and are persuasive. The rejection of claims 1 to 14 under 35 U.S.C. 103(a) as being unpatentable over Murray '119) in view of Thumm '332, has been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number:
10/792,297
Art Unit: 1793

Page 7

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/
Primary Examiner, Art Unit 1793

JPS